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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,523	12/23/2003	Honjung Lee	118109	7335
25944 7590 03/17/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
RAE, CHARLESWORTH E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,523

Applicant(s)

LEE ET AL.

Examiner

CHARLESWORTH RAE

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-73, 76-78, 84, 87 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 74, 75, 79-83, 85 and 86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments, filed 11/23/07, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of actions being applied to the instant application.

This action is made final.

Status of the Claims

Claims 1-88 are currently pending in this application.

Claims 1-73, 76-78, 84, 87, and 88 are withdrawn for being directed to non-elected subject matter.

Claims 74-75, 79-83, and 85-86 are under examination.

Amendment to the Specification

The amendment of Title of the specification is acknowledged.

Claim of Priority

Receipt of a non-English certified copy of the foreign priority application received 8/26/04 is acknowledged.

Response to applicant's arguments/remarks

Objection to the Specification

The objection to the Title of the specification is withdrawn in view of the amendment.

Rejection under 103(a)

Applicant contends that this rejection should be withdrawn for essentially the following summarized reasons (see applicant's Response received 11/123/07 at pages 4-8):

1) Okada, Simon, or Reinehr, alone or in combination, teach or suggest all of the instant claimed limitations. For instance, claims 74, 75, 79, 80, 85 and 96 are directed to a method of making up dark skin by applying a composition comprising at least one coloring agent and reflective particles; claims 81-73 are directed to a method for lightening dark skin by using a composition comprising at least one coloring agent and reflective particles; claims 74 and 81 further require that the composition has a hue angle h ranging from 40 to 70 degrees, and a saturation C^* ranging from 20 to 50; while claims 75 and 82 further require that the composition has a reflectance ranging from 10% to 45% in the range of from 600 to 680 nm. The cited prior references taken individually or combined failed to teach all these limitations (see applicant's Response received 11/23/07 at pages 4-7).

2) It would not have been obvious for one of ordinary skill in the art, in view of the teachings of the cited references, to have modified the disclosure of the cited references to use a composition having a hue angle h ranging from 40 to 70 degrees, and a saturation C^* ranging from 20 to 50, as required in claims 74 and 81, or a composition having a reflectance ranging from 10% to 45% in the range of from 600 to 680 nm, as required in claims 75 and 82.

In response, this rejection is maintained as applicant's arguments are not found to be persuasive for the reasons made of record in the Office action mailed and for the additional following reason:

a) It is the examiner's position that the hue angle and color saturation are coextensive properties of practicing the instant claimed method and that the determination of hue angle and color saturation are within the scope of knowledge and skill of an artisan skilled in the art as evidenced by prior art references listed on the accompanying Form 892.

Nonstatutory obviousness-type double patenting (ODP) rejection

Applicant contends that the ODP rejections should be withdrawn for essentially the following summarized reasons (see applicant's Response at pages 8-9):

1) The ODP rejection based on copending appl. 10/743,521 is rendered moot as this case is now abandoned. This rejection is withdrawn.

2) The ODP rejection based on copending appl. 11/172,977 should be withdrawn because claims 32-34 of said copending appl. do not teach or suggest all of the limitations of claims 74,75, 79-83, 85 and 86 (see also applicant's arguments set forth on pages 4-8 in connection to the Response to the rejection under 103(a).

In response, this rejection is maintained as applicant's arguments are not found to be persuasive for the reasons previously made of record in the Office action mailed 7/23/07 at page 10.

Rejections

Claim rejections – 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 74-75, 79-83, and 85-86 are rejected under 103(a) for being unpatentable over Okada et al. (US Patent 5,463,009), Simon (US Patent 6,451,294), and Reinehr et al (US Patent 6,818,205).

Okada et al. (US Patent 5,463,009) teach fluorine-modified silicone derived perfluoroalkyl water-repellant cosmetics for use in protecting the skin from water or for preventing makeup up from getting disordered by water or sweat in the form, for example, cosmetics for foundation (col. 1, line 17 col. 2, line 19; see cols. 11-13, Examples 4-8). Okada et al. teach a two-phase liquid foundation containing fluorine compound treated pigments, titanium oxide, iron oxide (red, yellow, and black), glycerin,

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ethanol, and water (col. 1, Table 2). Like Okada et al., instant claims 74-75, 79-83, and 85-86 encompass foundation type compositions. The glycerin, water, and ethanol, as taught by Okada et al., is reasonably construed to constitute a *physiologically acceptable medium*," as encompassed by said instant claims. The treated pigments as taught by Okada et al. reasonably constitute a "*coloring agent*," while the iron oxide (red, yellow, and black) reasonably constitute "*reflective particles*," as encompassed by said instant claims. Instant claim 74, encompass the limitation "*said composition having a hue angle from 40° to 70°, and a saturation C* ranging from 20 to 50*," are reasonably construed to be inherent characteristics of the composition. Okada et al. disclose an evaluation method for applying the foundation for wearability, retention, and feel on the skin (col. 11, line 52 to col. 12, line 18). Okada et al. teach that the retention of the foundation was evaluated in terms of the degree of removal of the foundation from the skin 8 hours after application. Instant claims 75 and 82, encompass the limitation "*said composition having a reflectance ranging from 10% to 455 in the range of from 600 to 680 nm*," which is reasonably construed to an inherent characteristic of the instant composition. Okada et al. do not teach specifically teach a method for making up dark skin or lightening dark skin.

Simon (US Patent 6,451,294; already made of record) a makeup kit combining a first, goniochromatic pigment and a second pigment, especially a monochromatic pigment, having one of the colors of the first pigment. This kit comprises two cosmetic makeup compositions which can be applied to the skin

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on both the face and other parts of the human body, to the lips and to the exoskeletal appendages such as the nails, eyelashes, eyebrows or hair; the invention also relates to a bilayer makeup method (col 1. lines 14-30). Simon teach said compositions for making up the skin in the form of a solid foundation (col. 8, lines 49-57; col. 8, line 64-67). Simon teaches reflectance of the composition as a function of wavelength (see Figure 1; see also col. 2, lines 6-11). The invention additionally provides a method of making up the human skin, lips and/or exoskeletal appendages, which comprises applying to the skin, lips and/or exoskeletal appendages a first layer of a first composition comprising a cosmetically acceptable medium and at least one first colorant and then applying to part of the said first layer a second layer of a second composition comprising a cosmetically acceptable medium and at least one second colorant, one of the first and second colorants being a goniochromatic colorant able to produce different colors depending on the light incidence and the viewing angle and the other colorant being a monochromatic colorant which produces one of the colors of the goniochromatic colorant (col. 2, lines 22-44). Instant claims 76, 79-80, 83, 85 and 86 encompass two compositions, which are applied separately as taught by Simon (col 2, lines 22-44). Simon does not teach making up dark skin.

Reinehr et al (US Patent 6,818,205) teach a method of using a polymeric carrier material treated with a fluorescent whitening agent for lightening human

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skin and for protecting human skin against UV radiation (col. 1, line 4 to 7; col. 4, line 65 to col. 14, line 27). Reinehr et al. teach disclose depigmentation compositions are preferably used in people with a naturally dark skin type that has elevated melanin concentration to lighten the skin (col. 1, lines 26-30). In view of the teaching of Reinehr et al., the method of lightening or darkening of the skin is reasonably construed to be within the knowledge and skill of an artisan skilled in the art given the level of skin pigmentation/melanin levels of the targeted subject population. Reinehr et al. further teach that the use of a polymeric carrier material treated with a fluorescent whitening agent allows the degree of whiteness of such formulations to be increased, while the UV-absorbing properties provide effective protection against the damaging effect of UV radiation (col. 17, lines 54-66).

Based on the teaching of Reinehr et al. that the polymeric carrier has the advantage of providing UV-absorbing properties, someone of skill in the art would have been motivated to combine the teaching of Okado et al., in view of Simon, in view of Reinehr et al. to create the instant inventive concept.

Thus, someone of skill in the art at the time the instant invention was made would have deemed it obvious to create the instant claimed invention with reasonable predictability.

Nonstatutory Obviousness-Type Double-Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 74-75, 79-83, and 85-86 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32-34 of copending U.S. Patent Application No. 11/172,977 (Appl. '977). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are either anticipated by, or would have been obvious in view of the referenced claims.

In particular reference claim 32 is directed towards a process for making up the skin. Unlike the instant claims, the reference claims do not recite a foundation type composition comprising reflective particles. To the extent that the reference claim recites the term "comprising," someone of ordinary skill in the art would reasonably envisage the addition of additional active ingredients to the composition.

Thus, claims 74-75, 79-83, and 85-86 are deemed obvious variants of the limitations of copending Appl. '977.

This is a provisional obviousness-type double patenting rejection because the conflicting claims of the copending applications have not in fact been patented.

Applicant is invited to respond to the examiner's request requiring applicant to review the claimed subject matter of US Patent 6,451,294 and 6,663,852, considered the same or similar, and submit appropriate Terminal Disclaimer(s) (see Office action mailed 7/23/07 at page 10, last para.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the

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Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5 February 2008

/C. R./ Examiner, Art Unit 1611

/Brian-Yong S Kwon/

Primary Examiner, Art Unit 1614